

## **REMARKS**

### **Summary of the Office Action**

In the Office Action, the Office:

- Rejected Claims 1, 8, 9, 15-17, 24 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Harris (WO 02/060653) in view of Akin (U.S. Patent No. 4,565,104);
- Rejected Claims 3 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Harris (WO 02/060653) in view of Akin (U.S. Patent No. 4,565,104) and in further view of Yamanaka (U.S. Patent No. 4,825,714);
- Rejected Claims 5-7 under 35 U.S.C. § 103(a) as being unpatentable over Harris (WO 02/060653) in view of Akin (U.S. Patent No. 4,565,104) and in further view of Zufle (U.S. Patent Application Publication No. 2003/0109953);
- Rejected Claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Harris (WO 02/060653) in view of Akin (U.S. Patent No. 4,565,104) and in further view of Zimmerman (U.S. Patent No. 6,494,005); and,
- Rejected the two affidavits submitted in response to the Non-Final Office Action of October 22, 2010 as improperly swearing behind Harris (WO 02/060653).

By this Reply, no Claims have been amended or cancelled. Accordingly, Claims 1, 3, 5-10, 15-18, 24 and 25 are at issue. In view of the following Remarks, Applicant submits that the Application is now in condition for allowance and requests same.

### **Interview Summary**

Applicant wishes to thank Examiner Pilkington for discussing the Application with the undersigned on February 7, 2011. A summary of the examiner interview follows.

In the Final Office Action, the Office directed Applicant's attention to a 50-day time period between April 23, 2002 and July 12, 2002 included in one of the two declarations submitted under 37 CFR § 1.131. The Office argued that a question of diligence may have been raised. The undersigned contacted Examiner Pilkington to point out that the Inventor's Declaration established an actual reduction to practice prior to the critical date of the Harris

reference, August 8, 2002. And, in the unlikely event that the Inventor's Declaration did not establish an actual reduction to practice prior to the critical date, under MPEP 715.07(a), the period for which diligence must be proved is from the critical date—August 8, 2002—until September 3, 2002 (only 26 days). *See* MPEP 717.07(a) (Under 37 CFR § 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive). Therefore, the 50-day time period between April 23, 2002 and July 12, 2002 was not material to the question of diligence.

The interview closed with Examiner Pilkington's advice to file a Reply to the Final Office explaining these facts.

**Swearing Behind Publication Date of Harris**

The Office rejected Claims 1, 3, 5-10, 15-18, 24 and 25 based primarily on Harris (WO 02/060653). Applicant respectfully submits that Harris is not prior art to the present Application.

Harris has a publication date of August 8, 2002 and qualified as prior art based on that date (the present Application having an earliest priority date of September 3, 2002). Applicant resubmits the attached Inventor's Declaration under 37 C.F.R. § 1.131 to swear behind the August 8, 2002 publication date, establishing a date of invention and actual reduction to practice prior to August 8, 2002 and eliminating Harris as prior art under 35 U.S.C. § 102(a).

Conception and actual reduction to practice are established by the Declaration. Namely, in email communication from the inventor to Paula Gomes, the inventor discussed the invention and attached a photograph of the partly assembled robot head of the invention. Please compare the photograph, showing the frame 10, the first lead screw 32, the bearing 34, and the motor 30', to FIGS. 1 and 3-8 of the Application. This email establishes, at least, conception prior to August 8, 2002. On a date subsequent to the date of the email to Paula Gomes, the inventor enclosed another photograph of the invention in an email to Acrobot. Please compare that photograph of the completely assembled invention, showing the arm 20 and the manually graspable driving member 30 on the arm, to FIG. 9 of the present application. Although some of the dates in the Exhibits to the Declaration were expurgated, the expurgated dates are prior to August 8, 2002.

In view of the foregoing, Applicant respectfully submits that a date of conception and actual reduction to practice prior to August 8, 2002 has been successfully established.

**Statement of Common Ownership of Harris**

Harris might still qualify as prior art as of its international filing date of January 29, 2002 under 35 U.S.C. § 102(e). However, under 35 U.S.C. § 103(c), Harris is disqualified as prior art to Claims 1, 3, 5-10, 15-18, 24 and 25 because the present application, Application Serial No. 10/526,258, and Harris were, at the time the invention of Application Serial No. 10/526,258 was made, owned by The Acrobot Company Limited, predecessor to the current assignee, Stanmore Implants Worldwide Limited.

Therefore, Harris is not prior art to the present Application.

**Conclusion**

As a result of the above Amendments and Remarks, Applicant respectfully submits that the Application is in condition for allowance. If any deficiencies remain, the Office is invited to telephone the undersigned to facilitate allowance of the claims.

Respectfully submitted,

Dated: February 28, 2011

By: /Peter M. Klobuchar/  
Peter M. Klobuchar, Reg. No. 43,722  
Ungaretti & Harris LLP  
70 West Madison Street, Suite 3500  
Chicago, Illinois 60602  
312.977.4416